IN THE HIGH COURT OF GUJARAT AT AHMEDABAD

FIRST APPEAL No 2155 of 2000

For Approval and Signature:

Hon'ble MR.JUSTICE D.P.BUCH

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1. Whether Reporters of Local Papers may be allowed to see the judgements? : YES

2. To be referred to the Reporter or not? : YES

3. Whether Their Lordships wish to see the fair copy of the judgement? : NO

4. Whether this case involves a substantial question of law as to the interpretation of the Constitution of India, 1950 of any Order made thereunder? : NO

5. Whether it is to be circulated to the Civil Judge? : NO

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CADILA HEALTHCARE LTD.

Versus

SWISS PHARMA PVT.LTD.

Appearance:

1. First Appeal No. 2155 of 2000

MR M J Thakore, Sr.Advocate with Mr BH CHHATRAPATI for appellant

MR PADMRAJ K JADEJA for Respondent No. 1

MR P M Thakkar, Sr.Advocate with Mr YJ TRIVEDI for Respondent No. 1

CORAM : MR.JUSTICE D.P.BUCH

Date of decision: 17/08/2001

JUDGEMENT

Whether "SUPERDAC" medicine manufactured, marketed and sold by the respondent herein contains a mark which is deceptively similar or identical with the mark "SPARDAC", a product of the appellant, is a question at controversy between the parties in this First Appeal.

2. The appellant above named has preferred this First Appeal under section 96 of the Civil Procedure Code, 1908 (for short, 'the Code') against the judgment and decree dated 25.8.2000 recorded by the learned Judge of the City Civil Court at Ahmedabad, in Civil Suit No.4754/98 under which the learned trial Judge dismissed the suit of the appellant-original plaintiff and further directed the appellant-original plaintiff to pay to both the respondents herein cost of the suit and to bear their own costs in the suit.

3. The main grievance of the appellant before the trial court was that the appellant had already marketed a medicine named SPARDAC somewhat over a year before the institution of the suit. The appellant also contended before the trial court that the respondents have been manufacturing , marketing and selling a medicine named SUPERDAC and the said process has been started little before the institution of the suit. The appellant contended before the trial court that the mark SUPERDAC is deceptively and/or confusingly similar to the appellant's trade mark SPARDAC and thereby, the respondents have committed an act of passing off their product SUPERDAC as the appellant's product SPARDAC.

4. The appellant contended before the trial court that initially CADILA was a common name for the appellant as well as the second respondent. There was a partition and therefore, the appellant continued its production, marketing and sale of medicine in the name of appellant, whereas, the second respondent started its manufacturing, marketing and sale of medicine in the name of Cadila Pharmaceuticals Ltd. Both of them are the Companies registered under the Companies Act, 1956.

5. The appellant contended before the trial court that the appellant had started production, marketing and sale of its product SPARDAC and had applied for registration of the said trade mark vide application dated 31.5.1996 under the provisions of Clause 5 part-A of the Trade and Merchandies Marks Act, 1958. (for short, 'the Act'). That thereafter, in November, 1996, the appellant started manufacturing and marketing the said product SPARDAC, a preparation of drug Super-floxacin, which is a potent anti-bacterial medicine

used to prevent bacterial infections viz; respiratory tract infections, urinary tract infections, etc. That the appellant adopted the trade mark SPARDAC for the first time in the trade industry adopting the mark "SPAR" in connection with drug spar floxacin and adopted mark "DAC" from the word "ALIDAC" which indicates the name ALIDAC Genetics and Pharmaceuticals which is a division of the original company CADILA.

6. The appellant also contended that the respondents have recently started manufacturing a medicine named SUPERDAC. That the said name is deceptively similar and identical with the medicine SPARDAC manufactured by the appellant. That the people at large would naturally be put to a confusion on account of the similarity appearing in the names of these two medicines. Therefore, the appellant filed the aforesaid suit to restrain, the respondents from passing off their goods as appellants' goods.

7. The respondents were duly served and they appeared and filed written statements. The first respondent filed written statement at Exh.36 and the second respondent at exh.35. There the facts were not much in dispute but it was mainly contended by the respondents that the medicine and its mark SUPERDAC is not deceptively similar or identical with the medicine and its name SPARDAC of the appellant. It is further contended that even looking at the face of the two medicines and their packings, it is not likely that people at large, would be confused by the alleged similarity in the name. That therefore, the appellant have no case and, therefore, the suit may be dismissed with costs.

8. The trial court framed necessary issues at Exh.37. After permitting the parties to lead evidence and after hearing their arguments, the trial court found that the appellant had failed in proving that the respondents had adopted their trade mark SUPERDAC which is structurally and phonetically identical and deceptively similar to and which is a colourable imitation of the appellant's trade mark SPARDAC creating confusion in the trade and market.

9. The trial court has also found that the appellant had failed to prove that the above referred adoption of their trade mark SUPERDAC by the respondents, constitutes violation of respondents' proprietary rights to the use of their trade mark SPARDAC and it is illegal and dishonest and with intention to pass off their goods as

those of the appellants.

10. On the aforesaid findings, the trial court found that the appellant was not entitled to claim any proprietary right over the trade mark SPARDAC and dismissed the above suit of the appellant. Feeling aggrieved by the said judgment and decree of the trial court, the appellant-original plaintiff has preferred this appeal before this court. It has been mainly contended here by the appellant above named that the trial court has failed to appreciate the facts of the case and has also failed in appreciating the legal position in respect of passing off. That the trial court has failed to appreciate that the appellant has clearly proved that the respondent has adopted their trade mark SUPERDAC and the same is structurally and phonetically identical and deceptively similar to the appellant's trade mark SPARDAC. That the trial court has failed to appreciate that the trade mark SUPERDAC adopted by the respondents constitutes violation of the appellant's proprietary right to use the trade mark SPARDAC. That this was an illegal and dishonest act done with intention to pass off their goods as those of the appellant's. That the trial court has also erred in not properly considering the fact that the appellant's product SPARDAC had built up a considerable goodwill and reputation which is reflected in the sale figures of this product SPARDAC. That on the whole, the judgment and decree passed by the trial court are illegal and erroneous and deserve to be set aside. The appellant has, therefore, prayed that the present appeal be allowed, the judgment and decree of the trial court be set aside and the suit of the appellant be decreed in terms of the relief prayed in the plaint.

11. On receipt of the appeal, notice as to admission of the matter appears to have been issued. Respondents have made appearance through their respective Advocates. With the consent of the parties, the matter has been heard finally and, therefore, it is being disposed of finally.

12. As stated above, the main and substantial question to be considered is as to whether the medicine named SUPERDAC manufactured, marketed and sold by the respondents could be treated to be containing a mark deceptively similar to the mark SPARDAC which is a medicine manufactured, marketed and sold by the appellant above named and that there is a likelihood of creation of confusion in the trade on account of the alleged similarity in the names of two products. It is not much in dispute that the aforesaid names of the medicines have

not been registered as trade mark and therefore, the question is of passing off and there is no question of infringement of trade mark. This fact is absolutely undisputed during the course of argument advanced by the learned Advocates for the parties.

13. The main argument advanced on behalf of the appellant by learned Sr.Advocate Mr Mihir Thakore is that the trial court has not properly considered the similarity between the names of the two medicines and the trial court has also not properly considered that there is a probability of confusion being created in the minds of the consumers, chemists and traders and even in doctors and therefore, this aspect is required to be reconsidered here. It is his argument that the two words are, on the face of them, deceptively similar and, therefore, there are all probabilities and possibility of confusion being created amongst the consumers, traders and even in Doctors in prescribing such drugs.

14. As against this, the learned Sr.Advocte for the contesting respondent, Mr P M Thakker has also argued at length that there is no similarity between the two brand names and hence, there is no likelihood of confusion in the minds of the traders, consumers or doctors. That "super" is usually put to use in many products including drugs and 'dac' is the reverse reading to the first three letters of CADILA, the name of the respondent company. That, therefore, there is no case of respondents' passing of their goods and medicines as that of the appellants.

15.1. The learned Advocates for the parties have relied upon certain decisions. In a case of Erven Warnink B.V. & Anr. v. J. Townend & Sons (Hull) Ltd. (RPC 1980 P 31), it has been observed that a misrepresentation made by a trader in the course of trade to prospective consumers of his or/and ultimate consumers of goods or services supplied by him which is calculated to injure business or goodwill or any trader causes actual damage to a business or goodwill of the trader by him. This is treated to be an action of passing off. There the dispute was between the two drinks 'Advocaat and 'Old English Advocaat'. There the difference was that the word 'Advocaat' was a generic and therefore, any one was free to make use of the said word and therefore, there was no action of passing off on the part of the defendants, since the plaintiff had no proprietary right in the said name.

15.2. A reference was made to a case of Roche & Co. v. Geoffrey Manners & Co.(AIR 1970 SC 2062). There the

Hon'ble Supreme Court has observed that the marks must be compared as a whole. That it is not right to take a portion of the word in order to decide if there is similarity to cause confusion. The true test is whether the totality of the proposed trade mark is such that it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade mark. The Supreme Court found that on comparison of the trade mark "Dropovit" and "Protovit" that they are not deceptively similar.

15.3. Another decision relied upon is in the case of Ciba-Geigy Ltd. v. Torrent Lab. (1993(1) 325. The question before the Court in that matter was whether ULCIBAN trade mark of respondent no.1 can pass off as the trade mark of the petitioner CIBA-Geigy Ltd? It was found that trade mark ULCIBAN could create confusion in the mind of public and could pass off as the trade mark of the petitioner Ciba-Geigy Ltd. This Court also found that the impugned trade mark is likely to cause deception or confusion in the trade and the public having regard to resemblance that it bears by virtue of incorporating within it the highly distinctive part CIBAN which is the registered trade mark of the petitioner who is also the proprietor of the other registered trade marks. That therefore, the proposed mark cannot be registered as a trade mark of respondent no.1 in view of the prohibitions contained in Sections 11(a) and 11(e) of the Act.

15.4. In O.J. Appeal No.11/93, the dispute was between the words "CIBA" and "ULCIBAN". At the time of registration, the Registrar of Trade Marks found that there is no likelihood of confusion or deception since the word 'ULCI' and 'CIBAN' were not identical or deceptively similar. It was also found that the letters 'ULCI' and 'BAN' are the two prominent features in 'ULCIBAN' which is absent in 'CIBA'. The matter went to the High Court and, there it was found that the word 'ULCI' was likely to cause deception. However, in appeal, the matter went otherwise and it was held that there was no likelihood of confusion or deception.

15.5. In the case of M/s. Ciba Geigy vs. Sun Pharmaceuticals Ltd., reported in 1992 (2) GLR 1053, this Court has observed that the test should not be that in no case a purchaser would commit a mistake but the percentage of the possibility or likelihood of committing such mistakes. There the dispute was between two words 'CLOFRANIL' and 'ANAFRANIL'. There the interim application was ordered to be dismissed showing that there was no similarity in such a way as to confuse the

consumer, the chemists or the trader.

15.6. In S.B.L. Ltd. v. Himalaya Drug Co., reported in AIR 1998 Delhi 126. the Supreme Court has considered the two words 'Liv. 52' and 'Liv.T'. There it was observed that the common feature 'Liv', abbreviation made out from the word 'Liver' is descriptive in nature and common in usage. It is further observed that both the products have no phonetic similarity and both the products were found to have distinctive features. Therefore, it was observed that the proprietor of 'Liv.52' would not be entitled to injunction restraining the use of 'Liv.T.' It was also observed that there are about 100 drugs in the market using the abbreviation 'Liv' made out of the word 'Liver', which is the organ of the human body.

15.7. In Indo-Pharma Pharmaceutical Works Ltd. v. Citadel Fine Pharmaceuticals Ltd., reported in AIR 1998 MADRAS 347, again the dispute was between two words 'Enerjex' and 'Enerjase'. The plaintiff was selling its product, allopathic medicinal preparation under the trade mark 'Enerjex'. On the other hand, the defendant sought to adopt the trade mark 'Enerjase' for selling Ayurvedic medicinal preparation. There it was observed that the prefix for both the marks viz; 'Enerj' is common and abbreviation of generic name 'energy'. Suffix to said words "Jex" and "Jase" are totally dissimilar and do not create confusion in the mind of users especially when visual impression of the said two trade names is completely different. It was also observed that the total sound effect of these two names does not have similarity and hence there is no infringement of trade mark of the plaintiff. It would be considered here that the two words contained seven and eight letters respectively. Out of that five letters were common in both the medicinal preparation. The suffix in one word was 'ex' whereas the suffix in the other word was 'ase'. It may be observed that the difference was very minor with respect to the suffix. but the words were looked at as a whole by the Hon'ble Court and there it was found that the suffix was quite different and there was no similarity phonetically or otherwise. While so doing the said court has considered numerous decisions on the aforesaid aspects. While deciding the matter, the court found that the two words 'jex' and 'jase' are totally dissimilar and not going to create any confusion.

15.8. In Kaviraj Pandit Durga Dutt Sharma vs. Navratna Pharmaceutical Laboratories, reported in AIR 1965 SC 980, it has been observed that when once the use by the

defendant of the trade mark which is claimed to infringe the plaintiff's mark is shown to be "in the course of trade", the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise, for then the infringement is made out. When the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered. In the present case, the undisputed fact is that the appellant's mark is not a registered trade mark and, therefore, the appellant is required to show that the mark used by the respondent is deceptively similar or identical so as to cause confusion in the minds of all concerned.

15.9. In an application of Bayer's Products Ltd., reported in (1947)2 All. E.R. 188 i.e. 64 RPC 125 C.A. the dispute was with respect to the two brand names, i.e. 'DIASIL' and 'ALASIL'. The former was for internal and external use. There was no user of mark. On the other hand, ALASIL was limited to "Sulphurdiazine Preparations" and was sold under a doctor's prescription and in a container being labelled "poison". It has been observed in it at page No. 773 and 774 as follows:

> "There was an argument, which was quite rightly put before us, to the effect that for the purposes of section 12(1), it is not the actual state of user that is conclusive or dominant' you have to look and see the description of goods for which the respective registrations are made or sought. It was pointed out, quite rightly, that the appellants have a registration which would cover, as I have already said, not merely sulphadiazine preparations, but any type of poison. It was said that there will be, therefore, an increased probability of deception if the appellants use their mark to the full extent to which they are entitled to use it, and the sub-section undoubtedly deals with that case and is not concerned with the limits of the actual user of the two marks; it is concerned with the ambit and scope of the registrations.
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> That argument, in my opinion, does not carry the matter any further. The possibility of confusion in the domestic medicine cupboard or by the invalid on the invalid's bedside table has to

assume that by some curious combination of circumstances, some coincidence, the two products would be in the medicine cupboard at the same time, or on the bedside table at the same time, otherwise there is no possibility of confusion. If the doctor had prescribed "Diasil", the patient would get "Diasil" into his medicine cupboard. The doctor has to give a written prescription and the chemist has to supply "Diasil" and that only, and I am nota going to assume that professional men of that character would make a mistake.

The same would apply if the patient got a sulphadiazine preparation with the Opponents' "Alasil" mark upon it. Both those drugs would have reached the patient under the doctors prescription and in accordance with the doctor's orders. Of course, I should say that the "Alasil" product would not necessarily be a sulphadiazine, but might be some other type of poison; but that really does not carry the matter any further than the case which we are now considering on the basis of the appellants' present trade, because in such case you have to assume that the patient has got into his possession and under his control an "Alasil" product, be it poisonous or non-poisonous, and a "Diasil" product. In the circumstances, that is an assumption which you have to make before the possibility of confusion can arise.

That argument is based on a number of assumptions of various degrees of probability. Speaking for myself, I feel that the likelihood of these various probabilities being found all to occur in the same case is so remote that I do not think that we would be justified in finding on that ground that the marks so nearly resemble one another that the registration of the Respondents' mark would be likely to deceive or cause confusion."

15.10. In Cadila Health Care Ltd. v. Cadila Pharma Ltd., reported in 2001 (2) GLH 53, there was a dispute between the two brand names i.e. "FALCITAB' and "FALCIGO". The Hon'ble the Supreme Court considered the principles governing an action for passing off and made following observations in para 35 :

"35. Broadly stated in an action for passing off on the basis of unregistered trade mark generally

for deciding the question of deceptive similarity the following factors to be considered:

(a) The nature of the marks, i.e whether the marks are word marks or label marks ora composite marks, i.e. both words and label works.

(b) The degree of resemblence between the marks, phonetically similar and hence similar in idea

(c) The nature of the goods, in respect of which they are used as trade marks

(d) The similarity in the nature, character and performance of the goods of the rival traders

(e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.

(f) The mode of purchasing the goods or placing orders for the goods, and

(g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks."

15.11. Thereafter in para 36, it has also been said that weight to be given to each of the aforesaid factors depends upon the facts of each case and the same weightage cannot be given to each factor in each case.

15.12. Again, the observations in para 33 are as follows:

"The decisions of English Courts would be relevant in a country where literacy is high and the marks used are in the language which the purchaser can understand. While English cases may be relevant in understanding the essential features of trade mark law but when we are dealing with the sale of consumer items in India, you have to see and bear in mind the difference in situation between England and India. Can English principles apply in their entirety in India with no regard to Indian conditions? We think not. In a country like India where there is no single common language, large percentage of population is illiterate and a small fraction of people know English, then to apply the principle

> of English law regarding dissimilarity of the marks or the customer knowing about the distinguishing characteristics of the plaintiff's goods seems to overlook the ground realities in India. While examining such cases in India, what has to be kept in mind is the purchaser of such goods in India who may have absolutely no knowledge of English language or of the language in which the trade mark is written and to whom different words with slight difference in spellings may sound phonetically the same. While dealing with cases relating to passing off, one of the important tests which has to be applied in each case is whether the misrepresentation made by the defendant is of such a nature as is likely to cause an ordinary consumer to confuse one product for another due to similarity of marks and other surrounding factors. What is likely to cause confusion would vary from case to case. However, the appellants are right in contending that where medicinal products are involved, the test to be applied for adjudging the violation of trade mark law, may not be at par with cases involving non-medicinal products. A stricter approach should be adopted while applying the test to judge the possibility of confusion of one medicinal product for another by the consumer. While confusion in the case of non-medicinal products may only cause economic loss to the plaintiff, confusion between the two medicinal products may have disastrous effects on health and in some cases life itself. Stringent measures should be adopted specially where medicines are the medicines of last resort as any confusion in such medicines may be fatal or could have disastrous effects. The confusion as to the identity of the product itself could have dire effects on the public health."

15.13. In the case of IRON-OX REMEDY COMPANY LTD.. v. LEEDS INDUSTRIAL COOPERATIVE SOCIETY LTD. reported in Reports of Patent, Design, Trade Mark cases. Vol.XXXIV p. 425, the plaintiffs used to sell "Iron ox Tablets". The defendant started sale of Iron Oxide Tablets. It was held that the defendant did not put IRON Oxide Tablets in market to satisfy the popular demand but in order to supersede IRON-OX Tablets.

15.14. In the case of Corn Products Refining Co. v. Shangrila Food Products Ltd. (AIR 1960 SC 142). The

dispute was with regard to the two preparations GLUVITA and GLUCOVITA. Para 18 shows following important observations:

"Again, in deciding the question of similarity between the two marks we have to approach it from the point of view of a man of average intelligence and of imperfect recollection. To such a man the overall structural and phonetic similarity and the similarity of the idea in the two marks it reasonably likely to cause a confusion between them.

The absolute identity of the two competing marks or their close resemblance is only one of the tests for determining the question of likelihood of deception or confusion. Trade connection between different goods is another such test. Ex hypothesi, this latter test applies only when the goods are different. These tests are independent tests. There is no reason why the test of trade connection between different goods should not apply where the competing marks closely resemble each other just as much as it applies where the competing marks are identical. Whether by applying these tests in a particular case the conclusion that there is likelihood of deception or confusion should be arrived at would depend on all the facts of the case.

15.15. On applying the principles as above, the finding was recorded as follows:

"The respondent applied for registration of the mark 'Gluvita' used with reference to biscuits manufactured by him. The appellant who had been using the registered mark, 'Glucovita' with reference to his glucose with vitamins opposed the application under section 8(a). It was established that the appellants' trade mark had acquired a reputation among the buying public.

Held applying the above tests that the commodities concerned were no connected as to make confusion or deception likely in view of the similarity of the two trade marks. Apart from the syllable 'co' in the appellant's mark, the two marks were identical. That syllable was not such as would enable the buyers in our country to distinguish the one mark from the other. Hence the respondents' mark could not be registered."

15.16. In a case of Ruston & Hornby Ltd. Vs. Z. Engineering Co., AIR 1970 SC 1649 the dispute was between 'RUSTAM INDIA' and 'RUSTON'. The plaintiff had its registered trade mark in the name of 'RUSTON' whereas the defendant started its product in the name of 'RUSTAM INDIA'.

15.16.1. The High Court had held in the said matter that there was an infringement of the trade mark of the plaintiff committed by the defendant. However, it was also observed by the High Court that the word 'India' as a suffix to Rustom was a sufficient warning to the purchaser and, therefore, the defendant could be allowed to use the combination. The plaintiff had preferred appeal by Special Leave to the Hon'ble Supreme Court. No appeal was filed by the defendant against the finding that use of word 'RUSTAM' constituted infringement.

15.16.2. The Hon'ble Supreme Court found that in view of the aforesaid fact, when there was no appeal preferred by the defendant against the judgement of the High Court, that finding could not be challenged in the Supreme Court. The Hon'ble Supreme Court also found that if the defendant's trade mark was deceptively similar to that of the plaintiff, the fact that the word 'INDIA' was added to the defendant's trade mark, was of no consequence and the plaintiff was entitled to succeed in its action for infringement of its trade mark.

15.16.3. It has also been observed that the test as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing-off action.

15.16.4. Therefore, the Hon'ble Supreme Court allowed the appeal of the appellant and the respondent was prevented by a permanent injunction from infringing the plaintiff's trade mark 'RUSTON' and from using it in connection with the engines, machinery and accessories manufactured and sold by it under the trade mark of 'RUSTAM' or 'RUSTAM INDIA'.

15.16.5. It is to be considered here that the Hon'ble Supreme Court has observed in the said decision that in the given set of facts the test of infringement is the same as for passing off action. It is also required to be considered that in the said matter the defendant had not filed any appeal challenging the finding of the High Court to the effect that there was a

deceptive resemblance between the word 'RUSTON' and the word 'RUSTAM' and, therefore, the use of the bare word 'RUSTAM' constituted infringement of plaintiff's trade mark 'RUSTON'. The Hon'ble Supreme Court has clearly observed that the said finding has not been challenged and therefore the Supreme Court should decide the matter further on the strength of the finding of the High Court.

15.17. Then there is a decision of Reports of Patent Design and Trade Mark Cases. It was a decision in the matter of application by John Taylor Peddie. There the application was made by the registered proprietor of trade mark 'Supervita' for further registrations of that word. There was opposition by the registered proprietors of trade mark consisting of or including the word 'Supavita'. There it has been observed that 'Supavita' so nearly resembles 'Supervita' as to be likely to deceive or cause confusion if they are used as marks for goods respectively of the same description.

15.18. Ultimately the Registration No.607.I74 was ordered to be removed from the register and the Registration No.6I8.418 was allowed to remain on the register.

15.19. In a case of Erven Warnink B.V. and Another Vs. J. Townend & Sons (Hull) Ltd., [1980] R.P.C. 31, the plaintiff's were selling a drink in the name of 'Advocaat' in the U.K. since 1911. Then in the 1976, their sales accounted for 75 per cent of the total market. In 1974, the defendants began to manufacture and sell a drink which they called 'Old English Advocaat'.

15.20. It has been observed that characteristics for a valid cause of action in passing off are as follows :

"(I) a misrepresentation (2) made by a trader in the course of his trade (3) to prospective customers of his or ultimate consumers of goods or services supplied by him (4) which is calculated to injure the business or goodwill of another trader (in the sense that it is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so.

(II) that a plaintiff must show (1) that his business consists of, or includes, selling in England a class of goods to which the particular trade name

applies; (2) that the class of goods is clearly defined, and that in the mind of the public, or a section of the public, in England, the trade name distinguishes that class from other similar goods; (3) that because of the reputation of the goods, there is goodwill attached to the name; (4) that he, the plaintiff, as a member of the class of those who sell the goods, is the owner of goodwill in England which is of substantial value; (5) that he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill by reason of the defendant selling goods which are falsely described by the trade name to which the goodwill is attached.

(III) that the principle established in the Champagne case was correct, viz., that a person competing in trade may not attach to his product a name or description with which it has no natural association, so as to make use of the reputation and goodwill which has been gained by a product genuinely indicated by the name or description and that it does not matter whether the persons truly entitled to describe their goods by the name and description are a class producing the goods and not merely one individual.

(IV) that it cannot make any difference in principle whether the recognisable and distinctive qualities by which the reputation of the type of product has been gained are the result of its having been made in, or from the ingredients produced in, a particular locality or are the result of having been made from particular ingredients regardless of their provenance.

(V) that the class of traders who have the right to describe their products as Advocaat and for whom the right forms a valuable part of their goodwill are those who have supplied and are supplying the English market with an egg and spirit drink in broad conformity with an identifiable recipe and, as in the champagne case, that class was definite and ascertainable.

(VI) that the essential characteristics for a valid cause of action in passing off were present and that there was no exceptional feature present which might justify, on grounds of public policy, withholding from a person who has suffered injury

in consequence of the deception practised on prospective customers or consumers of his product a remedy in law against the deceiver."

15.21. In Duncans Agro Industries Ltd. Vs. Somabhai Tea Processors (P.) Ltd., XXXVI(1) G.L.R. 380. The respondent-plaintiff started manufacturing of Sargam Tea and marketed the same w.e.f. 28th June, 1991. In fact, the process had commenced on 25th July, 1990 but the marketing started on 28th June, 1991. It seems that the defendant also started manufacturing tea in the name of 'SARGAM' from 31st August, 1991. While deciding this matter, this Court had considered many decisions of various authorities and Courts. In this matter the plaintiff-Company was carrying on the business of blending, processing and marketing tea under different trade marks. 'SARGAM' was one of the trade names of the plaintiff. The defendant started sale of tea in the said name 'SARGAM'. This Court found that the use of the same trade name 'Sargam' by the defendant could not be upheld. This Court found that the plaintiff had prima facie case and balance of convenience was in his favour and that irreparable injury would be caused to the plaintiff, if the interim relief was not granted. Therefore, the injunction granted earlier was confirmed by this Court in the above decision.

15.21.1. The facts remain that the word 'SARGAM' was used by the plaintiff earlier and the defendant introduced the same product in the same trade mark subsequent to the introduction of Sargam Tea in market by the plaintiff. The Court also found that the defendant tried to throw away the plaintiff from the market firstly by its money power and secondly by resorting to various tactics of dragging the plaintiff to various courts. This was a finding of fact on evidence on records. The Court also found that if the defendant was permitted to sell its tea under the trade mark or trade name - 'SARGAM' then that would certainly adversely affect the plaintiff's financial interest, and even a direction to the defendant to maintain accounts of its sale would not be an adequate remedy to compensate the plaintiff in the event of the plaintiff ultimately succeeding in the suit. So the ultimate decision of the Court was that there was a prima facie case as there was likelihood of confusion of mind of all concerned when the two trade marks were exactly the same. It may be noted here that the plaintiff as well as the dependent used the same brand name - 'SARGAM'. It was then quite unnecessary to go into the question of similarity or comparison.

15.22. In the case of GEIGY A.G. VS. CHELSEA DRUG AND CHEMICAL COMPANY LIMITED reported in Reports of Patent, Design and Trade Mark Cases, 1966 Page 64, the dispute was between two preparation "BUTAZOLIDIN" and " BUTAZONE". Then on comparison of the two words, it was found that the possibility of confusion was almost non-existent. Accordingly, the motion was dismissed. It has also been observed in the said judgment that, there is evidence from the defendants to show that a pharmacist had to inquire from a doctor who had given a prescription whether he meant one or the other. There is no indication as to why the mark was chosen. It becomes a relevant consideration to show that the choice is innocent.

15.22.1 An attempt was made to show in the present case that while introducing the new medicine in the name of SUPERDAC, the intention of the respondent is to see that there is a confusion between two mark SPARDAC and SUPERDAC. At the same time, it has been seen that there is no direct evidence to prove this point. Even, otherwise, by no stretch of imagination it can reasonably be inferred that the respondents have introduced the medicine in the name of SUPERDAC with a view to see that there is a confusion in the minds of the consumer, druggist and chemists between the two words, Super Dac and Spar Dac. It has also been observed in the judgement that the burden is on the plaintiff to prove that there is likelihood of confusion on account of similarity in the two words.

15.22.2. It is further observed as follows :-

"If I have to consider whether when the product phenylbutazone is being sold to the public there is a likelihood of confusion between the name BUTAZONE which contains the most distinctive part of the word phenybutazone and the word BUTAZOLIDIN, I would have thought that the possibility of confusion was almost non-existent. It seems to me that the word BUTAZOLIDIN, containing as it does a rather unusual ending to the word "zolidin" is highly unlikely to be confused with the word BUTAZONE. So, I arrive at the conclusion that the plaintiff company has failed to prove, failed even to produce prima-facie proof to me, that the word BUTAZONE

so closely resembles the word BUTAZOLIDIN as to be likely to deceive or cause confusion. I arrive at that conclusion firstly because that is the conclusion at which the evidence which deals with this matter seems to arrive and secondly because in my own mind it seems highly unlikely that confusion arises among the limited class of people who would have to deal with these products."

15.22.3.It is to be seen that in the said matter, even two pharmacists were examined by the defendant and they had testified to the effect that there was no likelihood of confusion and that there was a very clear distinction between the two words.

15.22.4 In the present case, there is no evidence about actual confusion or deception which might have taken place. We can take it that even likelihood of confusion or deception would be sufficient to pass a decree in the present matter. I do not find any material to show that even it can be said that there is a likelihood of confusion between the two words in the minds of the consumers, chemists and doctors.

15.23. Then we can turn to the case of RUCHE PRODUCTS LIMITED AND ANOTHER VS. BERK PHARMACEUTICALS LIMITED, reported in [1973] R.P.C., page :641. In the said matter, the dispute was with respect to the medicine sold in the name of "VALIUM". The plaintiff had manufactured the tablet, wherein, the word ROCHE was being introduced in a very small letters and on the other hand, the defendant had manufactured their tablets and they preferred the work "BERK" in place of ROCHE. The observation of the Court was as follows :-

"(1) that in all questions of passing off the point was, first, whether by reason of the adoption of some particular get-up, or some other distinguishing feature such as a name, the plaintiff had, because of the intrinsic distinctiveness of the name or get up that he had adopted or by reason of use, succeeded in establishing so far as some relevant public was concerned that that particular get-up, or that particular name, was a mark of origin and that it denoted goods to which it was applied as being his goods. On the evidence as it stood the court

was in no way satisfied that the particular appearance of the plaintiffs' pills so far as patients were concerned was indicative of origin at all.

(2) That the present case was to be distinguished from Hoffmann-La Roche Vs. D.D.S.A. (infra) in which the plaintiffs had at the outset chosen capsules of a highly distinctive appearance. No doubt the defendants in the present case would be reason of the appearance of their tablets, be able the more readily to secure acceptance for their pills from the ultimate purchasers. It was indeed for this very reason, as the defendants had admitted, that the white and yellow form of tablet had been chosen. To that extent it might be said, using the expression very generally, that they were copying the plaintiffs' tablets. But if what they were copying was non-distinctive there was not the slightest reason why they should not copy. An interlocutory injunction would be refused and the motion dismissed."

15.24.1 At the same time, it is required to be considered that in the aforesaid decision, it has been clearly observed that everybody is agreed on all sides that so far as the doctors and pharmacists are concerned, there is no possibility of confusion or deception. It was contended on behalf of the plaintiff that patients, particularly patients in a nervous condition develope a particular faith in some medicine, that they think, has done some good, they will go back to their doctor and want to get the same again. That even the patient go to the doctor with a request that the previously prescribed medicine may again be given to them or sometime, they insist for continuing the previous medicine.

15.24.2 At the same time even such type of evidence appears to be missing in the case before us and no such evidence as has been observed at page no. 470 in the said judgement has been indicated to me from the records of the trial Court.

15.25. In the case of J.R. KAPOOR VS. MICRONIX INDIA, reported in 1994-PTC, Page 260, the Hon'ble Supreme Court was required to deal with two words "MICROTEL" with Logo of "M" and "MICRONIX" with Logo "M". It appears that the parties were the partners. They separated. Under the terms of

compromise, the trade mark was allotted to the respondent plaintiff herein and thereafter, the appellant - defendant started his own business of manufacturing more or less the same goods in the name and style of M/s. Microtelematix with the trade name "MICROTEL". That their name Microtel, he took simple M as his logo with the letter and background designed completely differently. Both the logo "M" and the trade mark "MICROTEL" were in colour, viz. blue and red respectively.Thereafter, the respondent filed a suit and sought for injunction against the use of trade name "MICROTEL", the logo "M" and the packaging carton. The Court granted injunction and the Division Bench dismissed summarily the appeal and therefore, aforesaid appeal was filed by Special Leave. At the conclusion, the Hon'ble Supreme Court held that their Lordships do not find that the manner in which the said words are written by both the parties on their respective cartons are likely to misguide or confuse the buyers. While so doing, the Hon'ble Supreme Court compared the two words, the cartons, the colours and thereafter the aforesaid decision was recorded.

15.26. In the case of THOMAS BEAR & SONS (INDIA) LTD.. VS. PRAYAG NARAIN & JAGENNATH, reported in Reports of Patent, Design and Trade Mark Cases Vol. VIII, Page : 25, the appellants traded in smoking tobacco and cigarettes under marks containing a Red Elephant, and their goods were known by this name, their trade being in British India where there are no statutory provisions for the protection of Trade Marks. Subsequently, the first respondent began to sell chewing tobacco under a mark also containing an Elephant and the Appellants commenced a suit to restrain him from so doing. There was no evidence of actual deception, nor was any evidence offered as to the probability of confusion being created by the use of an Elephant on chewing tobacco. On the aforesaid facts, it was held that though a Court might in clear cases decide for itself as to the similarity of two words or marks, it could not decide as to the area of trade protected by the Appellants' Trade Mark except upon evidence, and that no such evidence having been offered the Appellants had failed to discharge the onus which lay on them as plaintiffs. Therefore, the appeal was dismissed. It was also observed in the said

matter that there is no statutory law in British India relating to Trade Marks and the law which is applied there on the subject is substantially the same as that applied in England before the Trade Marks Act, 1905. It has also been observed that right of property that may be acquired in such a Trade Mark is based on the proved association in the market of the device, name sign, symbol or other means in question with the goods of the plaintiff, so that the use by the Defendant on such goods of the Trade Mark will amount whether the Defendant intends it or knows it or not, to the false representation that the goods are manufactured or put on the market by the plaintiff. Again it has been observed that the vital element in such a case is the probability of deception and this may depend on a number of matters as well as the question of similarity of the marks or of the get-up. It is also observed that witnesses can be called to prove the circumstances and the places in which the articles are sold, the classes of persons who buy them, and whether they include persons who are illiterate or ignorant or the reverse, the manner in which the public are accustomed to ask for the articles, and any other matters which will assist the Court to decide whether deception is probable. It is also observed in the decision that the evidence of actual deception may be available, and if available, may be very valuable. It is further observed that there is no such person as an expert in human nature, and it is now well settled that a witness cannot be called to say that it is likely that purchasers of the goods will be deceived. It is also observed in the said matter that this can only be a matter of opinion formed after the dispute has arisen and too often without any judicial consideration of the opposing contentions. At the same time as observed in the said decision, a person who is accustomed to buy the articles in question may be called to say that he would himself be deceived, and cross-examination will often show what weight should be attached to such a statement.

15.27. The case of S.M. DYECHEM LTD. VS. CADBURY (INDIA) LTD., reported in 2000 PTC 297 SC refers to the ignorant customer. It has been observed in the said case that the kind of customer that the Courts ought to think of in these cases is

the customer who knows the distinguishing characteristics of the plaintiff's goods, those characteristics which distinguish his goods from other goods in the market so far as they relate to general characteristics. If he does not know that, he is not a customer whose views can properly be regarded by the Court. There appears to be a dispute between two words "PICNIC" and "PIKNIC". It has also been observed in it that the plaintiff must prove that essential features of his registered mark have been copied. The onus to prove 'deception' is on the part of the plaintiff who alleges infringement. A mark is said to be infringed by another trader if, even without using the whole of it, the latter uses one or more of its "essential features". The identification of an essential feature depends partly on the courts' own judgment and partly on the burden of the evidence that is placed before the Court. Ascertainment of an essential feature is not to be by ocular test alone; it is impossible to exclude consideration of the sound of words forming part or the whole of the mark. It is also observed in the aforesaid decision as follows:-

"In our opinion, in the present case, three tests to which reference has been made above, have to be applied. The first one is this : Is there any special aspect of the common feature which has been copied? The second test will be with reference to the 'mode in which the parts are put together differently? That is to say whether the dissimilarity of the part or parts is enough to mark the whole thing dissimilar (Kerly para 17.17 referred to above). The third test is whether when there are common elements, should one not pay more regard to the parts which are not common, while at the same time not disregarding the common parts? What is the first impression ?"

"As to the first test, whether there are any peculiar features of the common part which have been copied, it is seem that the peculiar aspects of the common features of PIKNIK namely the peculiar script and the curve have not been copied; then, as to the second test, we have to see the dissimilarity in the part or parts and if it has made the whole thing dissimilar. Absence of the peculiar script in the letters, the curve

and the absence of the caricature of the boy with a hat, in our view, have made the whole thing look dissimilar. Then, as to the third test, the above three dissimilarities have to be given more importance then the phonetic similarity of the similarity in the use of the word PICNIC for PIKNIK. That is how these three tests have to be applied in this case. On first impression, we are of the view that the dissimilarities appear to be clear and more striking to the naked eye than any similarity between the marks. Thus, on the whole, the essential features are different.

15.28. Therefore, if, in a given case, the essential features have been copied, the intention to deceive or to cause confusion is not relevant in an infringement action. Even if, without an intention to deceive, a false representation is made, it can be sufficient. Similarly, confusion may be created unintentionally but yet the purchaser of goods may get confused for he does not have the knowledge of facts which can enable him not to get confused.

15.28.1 On the question of the relative strength, the decision must go in favour of the defendant that there is no infringement and the High Court was right in refusing temporary injunction".

15.28.2 It is further observed in the said decision as follows:-

" It is well settled that the plaintiff must prove that essential features of his registered mark have been copied. The onus to prove 'deception' is on the part of the plaintiff who alleges infringement. A mark is said to be infringed by another trader if, even without using the whole of it, the latter uses one or more of its "essential features". The identification of an essential feature depends partly on the courts' own judgement and partly on the burden of the evidence that is placed before it. Ascertainment of an essential feature is not to be by ocular test alone; it is impossible to exclude consideration of the sound of words forming part or the whole of the mark. (Kerly, Law of Trade Marks and Trade Names, 11th Ed. 1983, Para 14.21).

15.28.3 It is no answer to a charge of infringement as

contrasted with a passing off action - that the defendants' mark, whilst including the plaintiff's mark, includes other matters too. Still less is it an answer that by something outside that actual mark the defendant has distinguished his goods from those of the plaintiff - by adding his own name (kerly para 14.22). But this principle is not absolute. It is also accepted that addition of his own name by defendant is an element to be considered and may turn the scales in favour of the defendant".

15.28.4 Thereafter, the Hon'ble Supreme Court has further observed that " it was admitted that the words 'Ruston and Rustam" were deceptively similar and the fact that to the latter. "India" was suffixed made no difference. The Court pointed out the difference between an infringement action and a passing off action and held that if there was colourable imitation, the fact that the get up was different was not relevant in an infringement action thought it might have had relevance in a passing off action.

15.28.5 The Hon'ble Supreme Court has further observed in the judgement that it is seen that having aspects of the common features of PIKNIC namely the peculiar script and the curve have not been copied; then, as to the second test, we have to see the dissimilarity in the part or parts and if it has made the whole thing dissimilar. Absence of the peculiar script in the letters, the curve and the absence of the caricature of the boy with a hat, in our view, have made the whole thing look dissimilar. Then, as to the third test, the above three dissimilarities have to be given more importance then the phonetic similarity or the similarity in the use of the word PICNIC for PIKNIK. That is how these three tests have to be applied in this case. Their Lordships have also observed that in the first impression, their Lordships are of the view that the dissimilarities appear to be clear and more striking to the naked eye than any similarity between the marks. It has also been observed in the said judgement that in a passing off action the "decree of similarity of the name, mark or other features concerned is important but not necessarily decisive, so that an action for infringement of a registered trade mark may

succeed on the same facts where a passing off action fails or vice versa.

15.28.6 The Hon'ble Supreme Court also found that the trial Court in the present case went wrong in principle in holding that there was scope for a purchaser being misled.

15.29. In the case of The Himalaya Drug Co. v. Warner Lambert Pharma Co. (1969 BLR 525), the petitioner had prior use and registration of the trade mark 'NARDYL' and hence, they objected to the application of the respondent for the registration of the trade name "NARDELZINE". The pertinent observations at page 533 are as follows:

> There is no exact yard-stick for measuring probabilities. If probabilities of confusion are not so large as to be classified as reasonable, registration cannot be refused under s. 12 (1). But yet, if the probability is appreciable and not such as, one would say, "one in a million" or "too fanciful" or "too remote," such probability can be taken into account while considering the question of the exercise of discretion under s. 18 against registration. But a mere existence of such probability would not, by itself, justify the exercise of discretion against registration. Something more must co-exist along with such probability. In the present case, such an additional factor does exist. That additional factor is the disastrous consequences which would follow if a confusion does occur. After all, the goods to which both the rival marks are to apply are drugs or pharmaceutical products and not articles like toys or combs or shoes or the lie, in which cases confusing one mark for the other would no result in some appreciable harm, if any at all. The discretion has been granted by the statute for the protection of the public. In the case of drugs and pharmaceutical products the public the ailing public, requires a very great degree of protection and particularly so when the result of a confusion occurring would be disastrous. This principle can be found from the Judgments In the matter of an Application for a Trade Mark by Lewis Thomas Edwards", In the matter of an Application by Baye Products, Ltd. and in the Matter of an Opposition by A. Wander Ld. and In the matter of the Trade Marks Act, 1938, and in the Matter of Vitamins Ld.'s

Application for a Trade Mark. These circumstances therefore, call for the exercise of discretion against the registration of the respondent's trade mark."

15.30. In "Cases and Material on Trade Marks" , the plaintiff was the owner of a registered trade mark OPTREX. The defendant was allowed to use that word. It was limited to the period under agreement. The agreement was duly terminated by notice. Therefore, the defendant could not, naturally, use that trade name after the termination of the agreement.

15.31. In Anglo-French Drug Co.(Eastern) Ltd. M/s. Belco Pharma (Haryana) found at page 1183 in Cases and Materials on Trade Marks, the plaintiff had a registered trade mark in a brand name BEPLEX. It was observed that the sound is visually and phonetically similar and since the plaintiff has his brand name registered, the defendant cannot make use of such a similar mark.

15.32. BETALOC and BETALONG were the two brand names in a dispute in a case between Astra-IDL Ltd. v. T T K Pharma Ltd. (p.620, Cases & Materials on Trade Marks). It was found that when the two names are visually and phonetically similar, when looked as a whole, there is a reasonable likelihood of confusion and hence injunction ought to be issued. It has also been observed that the two words are so similar that, there is reasonable confusion between the two. That, there is no question of microscopic inspection but general or casual view from the customer's point of view be taken. That actual deception is not necessary. Following observations may be noted:

"(a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks i.e. both word and label marks;

(b) The degree of resemblance between the marks phonetically, visually as well as similarity in idea;

(c) The nature of the goods in respect of which they are used as trade marks;

(d) The similarity in the nature, character

and purpose of the goods of the rival traders;

(e) The class of purchasers who are likely to buy the goods bearing the marks, their level of education and intelligence and the degree of care they are likely to exercise in purchasing the goods;

(f) The mode of purchasing the goods or placing orders for the goods; and

(g) Any other surrounding circumstances."

15.33. VOLTAREN and VOLTA-K were the two brand names involved in Ciba Geigy Ltd. v. Crosslands Research Laboratories Ltd. (1996 PTC (16)) before the High Court of Delhi. The pertinent observations are as follows:

(a) It is the duty of the Court to compare the words as a whole and considering the question of similarity in the context of the practice in the trade in question.

(b) What happens is when a doctor gives a prescription, say VOLTAREN i.e. taken to the medical shop and the medical shop tells the patient that Volta-K is available in his shop and it is the same as Voltaren. The medical shop man also does not know the difference and he may unknowingly say Volta-K thinking that is the product of the plaintiff Co. That is where the confusion would arise. Therefore, the argument that the scheduled drugs are sold only on prescription and, therefore, there is no scope for any confusion cannot at all be advanced. Having regard to the globalisation of the economy, when several drugs are coming into the market from the manufacturers abroad and here, the persons in the market are apt to get misled by the trade marks.

(c) Proof of a fraudulent intention is not a necessary element in a cause of action for passing off.

(d) The question of likelihood of confusion is a matter for the eye of the Judge. The

question is not whether the Judge himself would be deceived by the defendant's get up; the question is whether in the light of whole admissible evidence the Judge is persuaded that an average shopper, shopping in the places in which the article is available for purchase and under the usual conditions in which such a purchase is likely to be made is likely to be deceived.

(e) The question is not how the defendant came to use the name Volta-K but the question is whether Vlta-K is deceptively similar to Voltaren. The plaintiff might have coined the word Voltaren from different words.

(f) I would add whether the doctors would be remembered to remember the trade names and distinguish between the product of the plaintiff and the defendant in the instant case. I answer the question in favour of the plaintiff and say that the doctors would not be able to distinguish and would be under the impression that Volta-K is a product from CIBA Geigy."

15.34. In Amritdhara Pharmacy v. Satya Deo Gupta (AIR 1963 SC 823), 'Amritdhara' and 'Lakshmandhara' were found to be similar. It has been laid down in it as follows:

"The question had to be approached from the point of view of a man of average intelligence and imperfect recollection. To such a man the overall structural and phonetic similarity of the two names 'Amritdhara' and 'Lakshmandhara' was likely to deceive or cause confusion. The overall similarity of the two composite words 'Amritdhara' and 'Lakshmandhara' had to be considered. It could not be said that no Indian would mistake one for the other. An unwary purchaser of average intelligence and imperfect recollection would not split the name into its component parts and consider the etymological meaning thereof or even consider the meaning of the composite word as 'current of nectar' or 'current of Lakshman'. Where the trade relates to

> goods largely sold to illiterate badly educated persons, it is no answer to say that a person educated in the Hindi language would go by etymological or ideological meaning and see the difference between 'current of nectar' and 'current of Lakshman'. The use of the word 'dhara' was not by itself decisive of the matter, what had to be considered here was the overall similarity of the composite words, having regard to the circumstances that the goods bearing the two names were medical preparations of the same description, though a critical comparison of the two names might disclose some points of difference. The trade mark is the whole thing-the whole word has to be considered. On a consideration of all circumstances, the overall similarity between the two names in respect of the same description of goods was likely to cause deception or confusion within the meaning of section 10 (1) of the Act."

15.35. Page 1016 of "Cases and Materials on Trade Marks", refers to a case of RANBAXY LABORATORIES v. DUA PHARMA. The dispute related to the trade marks CALMPOSE and CALMPROSE. It was held that the two words are phonetically similar and that addition of a single letter without altering its its phonetic sound does not make it dissimilar. It has been noted in it that -

> "The test to be adopted is not the knowledge of the doctor, who is giving the prescription. The test to be adopted is whether the unwary customer, who goes to purchase the medicine can make a mistake".

16. We can now turn to the case on hand, while keeping in mind, the observations made and principles enunciated in the above cases.

It is not much in dispute that these drugs are the Schedule 'H' drugs and, therefore, ordinarily, it is necessary to have a prescription for sale and purchase of these two medicines. There is no dispute about the same. However, we may take into account the argument that simply because a drug is a scheduled drug, it does not mean that it is not being sold and purchased without any prescription. It is also an argument that

in practice, this schedule 'H' drugs are being sold and purchased without prescription also. This argument is required to be taken into account while deciding the appeal finally.

17. As stated above, the trial court has taken the matter from different corners and angles and found that there is no deceptive similarity in the two names and therefore, the suit was dismissed. On going through the judgment of the trial court as well as the memo of appeal and on thought being given to the arguments advanced by the learned Advocates for the parties, I am of the view that the trial court has not committed any error in dismissing the suit after holding that the appellant has failed to prove that the name SUPERDAC is deceptively similar and identical to the name SPARDAC so as to create confusion in the minds of the consumers, traders and Doctors and, therefore, there is no merit in the appeal and the appeal is required to be dismissed. When the appellate court substantially agrees with the findings and reasonings recorded by the trial court, it is not very much necessary for the appellate court to go into detailed discussions and reasons for confirming the findings recorded by the trial court. However, in the present case, I find that the learned Advocates for the parties have taken me through various decisions of various courts. They have also taken me through the judgment of the trial court. The arguments have been advanced at length and they it continued for a number of sittings. Therefore, it would be in the interest of justice and of the parties to see that the arguments advanced by them are considered in some details.

18. Learned Sr.Advocate for the appellant has argued at length that the names SUPERDAC and SPARDAC are so similar that it would create confusion in the minds of consumers, traders and Doctors. So far as the Doctors are concerned, it will be very difficult for this court to agree with the aforesaid argument. The Doctors are expected to know the difference between the medicinal elements contained in these two medicines. The ingredients are different, their effects are different and their use is different. Therefore, the medicos are naturally expected to know the difference between the two. Therefore, it cannot be said that while prescribing medicine, a Doctor is likely to prescribe one medicine for another medicine on account of the alleged similar names of medicine, even otherwise, the persons practising in medicine are quite experts and, therefore, they are expected to be vigilant in prescribing medicine. Therefore, they are not

expected to commit any mistake or error while preparing these prescriptions and they are also not expected to write the name of one medicine in place of another while prescribing medicine for their patients.

19. So far as the chemists are concerned, it is also expected from them that they should closely read the names of the medicines prescribed by the Medical Officer or Private Doctors in their prescriptions. Therefore, also it is not likely that the traders will commit some error in supplying one medicine in place of another. It has also been argued by Mr Mihir Thakore, learned Sr.Advocate for the appellant that the handwritings of the doctors are not very good and, therefore, mistake is not unlikely. If the mistake is committed on account of the handwritings of the Doctors then for such mistake, similarity in name is not necessary. Mistake cannot be attributed to the similarity in the names of two medicines. It has also been contended that the two medicines are scheduled in schedule 'H' medicine and, therefore, it is necessary to have prescription of registered Medical Officer before sale and purchase of these two medicines, the practice is otherwise and at times, such medicines are sold and purchased without insisting on the prescriptions.

20. Now we can take it for granted that simply because the medicine is scheduled in schedule 'H' drug and it is sold and purchased only on the strength of prescription issued by the Medical Officer, it does not mean that such a medicine is never sold without insisting on prescription. Therefore, we take it that in practice, at times, medicines comprises Schedule 'H' may be sold without insisting on prescription of a registered Medical Officer as argued by Mr Thakore, learned Advocate for the appellant.

21. However, at the same time, we should also consider another aspect of the case. If a medicine is a schedule 'H' Medicine and if it cannot be sold without prescription to be issued by authorised Medical Practitioner and if a trader or a chemist sells it without prescription, then certainly, he does it at his own risk. Same way, if a consumer or a patient, purchases such a medicine without having prescription of an authorised Medical Practitioner, then he also does it at his own costs and risks. Therefore, similarity in the names of the two medicines will not be material for the purpose of sale of such medicines without insisting on prescription. Therefore, there is a protection given to such medicines when they are shown in Schedule 'H'.

Apart from the aforesaid aspect of the case, we may also consider the fact that as per the argument, the practice prevailing in the State and in the country is that the medicines shown in Schedule 'H' are also being sold without insisting on prescription. Even then, the names are not so deceptively similar and identical that there would be some error or confusion either on the part of the consumer or on the part of the trader. Since the medicines are stated to be sold and purchased without the prescription of a Doctor, we take it that Doctors are not in picture. Therefore, there is direct dealing between the trader and the consumer.

22. Learned Sr. Advocate for the appellant has argued at this stage that patients may make some mistake in getting one medicine in place of another. For instance, a patient in need of SPARDAC, because of failure of memory, may demand SUPERDAC. Now even when we take it that there may be some failure of memory on the part of the consumer, similarity or dissimilarity in names of medicine may not be in picture and it may not be the centre. Even otherwise, I am of the opinion that the two names are not deceptively similar so as to create confusion in the minds of consumer and under the said confusion or confused state of mind, the patient or consumer would name SPARDAC instead of SUPERDAC. When the patient goes to the chemists for a particular medicine without any prescription and on the strength of his memory, then, normally, it can be gathered or inferred, with respect to a reasonably prudent consumer, that he would not purchase a medicine unless he properly remembers the name of the medicine itself. Therefore, if he goes to purchase SPARDAC, he would not name SUPERDAC. Even otherwise, if he is confused about the name of the medicine he intends to purchase and if he does not have prescription for the same, then in that event, it may be that he may consult the chemist or doctor to clarify the position. The learned Sr.Advocate Mr P M Thakkar for respondent no.1 has argued at length that at times even when some confusion is found, the Chemists may inquire either from doctor on phone or the chemist may enquire from the patient as to what is the disease for which the medicine was sought to be purchased. This may again be a matter of practice with respect to some chemists and not with respect to all chemists in the world. The main thing is when there is a failure of memory on the part of the consumer then the fault cannot be attributed to the alleged similarity in the names of two medicines.

23. It would be relevant to consider that so

far as the SPARDAC is concerned, the emphasis is on 'a' and its pronunciation is quite different staring with 's'. The letter's' is not being pronounced fully and it does not have a vowel to follow it like a, e, i, o, u, y. It is followed by a non-vowel letter 'p' and hence 's' has a half-pronounciation. On the other hand, so far as SUPERDAC is concerned, the emphasis is on 'u' and therefore, the pronunciation starts from 'su'. Therefore, though the last letters DAC are common in the two medicines, the two words 'Spa' and 'Sup' cannot be treated to be similar from any corner of imagination or from viewing the matter from any corner. Even sound of the two words is not identical or similar. Therefore, when a consumer goes to a chemist for buying SPARDAC, it is not likely that he would not properly pronounce the word SPARDAC and the chemists would hear and follow and understand it as SUPERDAC in place of SPARDAC. Even the pronunciation are not similar or identical, much less, deceptively similar or identical.

24. Even appearance of the two medicines is quite different. The parties have gone through the evidence and during the course of evidence on the two products their strips have been produced on record. There is no dispute about the same. If we consider the product SPARDAC manufactured, marketed and sold by the appellant, it would be apparent that the word SPARDAC has been distinctly prepared. We find that in the words SPARDAC, 'a' comes twice. The strip of the medicine clearly indicates that letter 'a' at both the places is differently placed with the word SPARDAC. It can be said that the letter 'a' at both the places has been introduced in the words SPARDAC artistically. The strip of the medicine SPARDAC clearly indicates that the word SPARDAC 200 is a medicine in which the entire word SPARDAC has been written in capital letters, meaning thereby, each letter is in capital. Same way, the tables are round in shape and small in size.

25. We also find in the medicine SPARDAC 100, the strip is also on record. Here we find that there is a red cross and in horizontal, the word SPARDAC 100 is mentioned. The letters are in white colour and they are written in the red cross. The medicines are again small in size and round in shape.

26. If we consider the medicine SUPERDAC, it would appear that there is no such red cross appearing at any place of the strip. The word SUPERDAC is having 'S' capital. The remaining letters are not in capital. Then, the size of the medicine is quite different. The

shape of the medicine is also quite different. Therefore, on an apparent look at the two medicines, it cannot be said that there would be any chance for confusion with respect to the consumer, trader or doctor. Therefore, if a consumer goes to purchase a particular medicine, say, he goes to purchase SPARDAC and purchases the same. On the next occasion also he goes to purchase the same medicine. Even on a bare look at the strip of the medicine, he will be able to gather that what he purchases is SPARDAC and not any other medicine. Therefore, the appearance and get-up of the two medicines are such that there is no likelihood of any sort of confusion amongst the traders, consumers and doctors.

27. Having regard to the above referred discussions, observations, principles emerging from various decisions and considering the fact situation in the case on hand, the arguments advanced by the learned Sr.Advocates appearing for both the sides and after considering the observations and findings of the trial court along with the reasons for such findings, following observations may be made in respect of the case on hand.

28. We can also look at the strips of the two medicinal preparations.

- The word SPARDAC is entirely in capital letters with 'A' at the third and the sixth place is written artistically as said above. The word SUPERDAC shows only 'S' in capital letter and rest in small letters.

- Then, the word 'CADILA' in SUPERDAC is found with prominence and in capital letters which is not present with SPARDAC.

- The colour and get up of the two strips of these two medicines are noticeably different.

- The colour and the get up of two medicines are different.

- The size of the two medicines is different

- The shape of the two medicines is

different

- Their cartons are clearly different. There also, the size, colour and get up of the cartons are distinct.

- Since the letter 'U' immediately follows the letter 'S' in SUPERDAC, the pronounciation of the two medicines are different as 'S' is followed by 'P' and then by 'A' in SPARDAC.

- 'DAC' is common in both. Then SUPER has five letters whereas SPAR has four. This makes lot of different.

- SUPERDAC sounds differently from SPARDAC

- Even on a bare look at the two words 'SPARDAC' and 'SUPERDAC' both are apparently different. So, there is no visual similarity between the two.

- As per the records of the trial court, SUPERDAC strip has a writing on it in capital letters which reads 'CIPROFLOXACIN & TINIDAZOLE TABLETS'.

- SPARDAC 200 has a waiting on its strip which reads as 'SPARFLOXACIN TABLETS'

- SPARDAC 200 has also a writing in Hindi _____200 which is absent in SUPERDAC.

SPARDAC 200 has a read triangle on the strip. This is not there in SUPERDAC.

- SPARDAC 100 has a read cross on the strip, which is clearly visible as a prominent factor which is not there on the strip of SUPERDAC.

- The strip of SUPERDAC has red right angle at the right bottom corner. This factor is absent in the case of strips of SPARDAC.

- The word CADILA is in capital letter on the strip of SUPERDAC. It is not there in case of SPARDAC 200. SPARDAC 100 HAS THE

WORDS zydus Cadila which word do not find place in SUPERDAC.

- The price is different.

29. An attempt was made to argue that many customers may be ignorant and some of them may not be even literate and they are likely to commit error and would name one instead of another. It is difficult to swallow this argument. Such a customer may not be expected to wrongly name one medicine in place of another. In fact ignorant and illiterate customer would hardly go to purchase such a drug without a prescription. It is not possible to accept that such a customer would even remember the names of these two medicines. Even the name of one medicine may not be remembered by such a customer. In other words, it is not likely that such an ignorant or illiterate customer may commit an error in naming a particular medicine of his requirement.

30. Moreover, as said above, the get up, colour, size, shape and the price of these two products are prominently different. Therefore, even ignorant or illiterate customer is not likely to be confused. He can identify the drug of his requirement from all these factors and distinct marks appearing on the strips as well as on tablets themselves.

31. Even looking to the major and noticeable difference between the two drugs even the employees of a chemist shop are not likely to supply one drug in place of another.

32. Moreover, the chemist's shops are required to have a permanent skilled and qualified person to attend the shop, under whose supervision, all the activities of supply of drugs would go on. This further reduces chances of any mistake.

33. Even if such a qualified person is absent and the customer goes to a chemist for the purchase of a drug, looking to the above facts, even the employees of a chemist are not likely to commit any error.

34. While considering probabilities and possibilities of confusion or deception, one has to consider reasonable probabilities and reasonable possibilities. The above factors indicate that there is no likelihood that there would be reasonable probability or possibility of any sort of confusion.

35. As against this, there is no case or evidence about actual confusion. We take it that there is no necessity for the appellant to prove actual deception or confusion. But the cumulative effect is that there is neither any proof of actual deception or confusion nor is there any sort of likelihood of such a deception or confusion in the minds of the customers, chemists or doctors including ignorant or illiterate or semi-literate customer or a chemist even in absence of a qualified pharma personnel.

36. In short, the two brand names of these two medicines - SPARDAC & SUPERDAC are not identical or deceptively similar and it is not likely that the product SUPERDAC would be passed off in the name of SPARDAC.

37. As said above the trial court has considered the oral and documentary evidence on records and the same has been properly appreciated by it. It has been submitted that some decisions cited have not been discussed. Even if it is true, then it seems that the principles laid have been, by and large, considered by the trial court.

38. The trial Court seems to be right in recording a finding that the two products are not visually, structurally or phonetically identical and they are not deceptively similar so as to confuse the users, doctors or chemists. This Court is in general agreement with the findings and reasonings of the trial court. In that event, as said above, it is not necessary to go into detailed discussion. However, this is a first Civil Appeal hence it is a final court of fact. The matter has been argued at length by the learned Advocates for the parties. Therefore, I have dealt with the issues raised by the learned Advocates for both the sides in possible brief manner. The trial court is not shown to have committed any error on fact or law.

39. As discussed earlier, I am also of the opinion that the two products are not identical or deceptively similar and there is no likelihood of confusion in the minds of chemists, doctors or consumers. In my view, the judgment and decree of the trial court are, therefore, not illegal or erroneous.

They deserve to be confirmed.

40. In the facts and circumstances of the case, and for the foregoing reasons, this Appeal is dismissed and the judgment and decree of the trial court are hereby confirmed.

41. However, looking to the contentions of the rival parties, there shall be no order as to costs as regards this appeal.

Date:17.8.2001 [D P Buch, J.]
msp